UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,209	09/09/2003	Toshiyuki Noguchi	00862.023227.	9145

5514	7590	07/12/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	10/657,209	NOGUCHI, TOSHIYUKI	
	Examiner	Art Unit	
	Manglesh M. Patel	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *14 April 2006*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3,5,10,11 and 15-21* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3,5,10,11 and 15-21* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This **FINAL** action is responsive to the amendment filed on April 14, 2006.

2.   Claims 1,3,5,10-11 and 15-21 are pending. Claims 2, 4, 6-9 & 12-14 have been canceled. Claims 1, 10, 11, 16, 20 and 21 are independent claims.

Withdrawn Objections

3.   The objection to claims 11-12 & 14 has been withdrawn in light of the amendment.

Withdrawn Rejections

4.   The 35 U.S.C. 112, second paragraph rejection of claims 3-7, 9-10 & 13 have been withdrawn in light of the amendment.

5.   The 35 U.S.C. 102(e) rejections of claims 1-14 with cited references of Kelley U.S. 6,320,671 has been withdrawn in light of the amendment.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1,3,5,10-11 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta (U.S. 6, 980, 319, filed on Mar 2, 2001) in view of Lin (U.S. 6,757,070 filed on Aug 21, 2001).

Regarding Independent claims 1, 10, 11, 16, 20 and 21, Ohta discloses an information processing apparatus comprising: Selection means for selecting data to be printed (column 7, lines 25-40, wherein the keyboard and mouse are used to select data for printing); Although Ohta describes a portable digital device connecting to a network that includes accessing various print stations by letting the user select one of the stations, which is part of the condition list he fails to explicitly teach all the features of a condition list

associated with a printer type (column 2, lines 17-67). Lin discloses reception means for receiving <u>a</u> <u>recommended printing condition list</u> transmitted from another apparatus connected through a network (fig 7 & column 2, lines 30-61, wherein the universal print driver includes receiving a condition list which includes the features of the printer. Instead of installing multiple drivers the universal driver allows a user to access all the properties of multiple printers located on a network, those properties are the condition list as shown in figure 7); Storage means for storing a function expansion program for the browser, said function expansion program including acquisition <u>means for acquiring information of printers list</u> creation <u>means for creating a</u> <u>printing condition selection list on the basis of the recommended printing condition list and the information of</u> <u>printers, and instruction means for instructing a printer to print the selected data to be printed on the basis of</u> <u>data that is input by a user in accordance with the printing condition selection list</u> (fig 7 & column 2, lines 30-61, wherein the browser allows the user to select a specific printer, therefore it includes a printer list and its printing properties such as paper size, paper source etc..). Ohta teaches a device connecting to a network to access a group of printers. Lin also teaches a device accessing a group of printers further allowing the device to have all the features of a particular printer by having a universal driver; these features make up the printing condition list. Both Lin and Ohta are analogous art because they are from the same field of endeavor of network printing. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a printing condition list prior to printing. The motivation for doing so would have been to allow the user to have access to all the features of a particular printer thereby improving the print quality of the information. Therefore it would have been obvious to combine the teachings of Lin and Ohta for improving the quality of printed documents by allowing the user to have full access to the printer features by implementing a universal driver.

Regarding Dependent claims 3 and 17, Ohta discloses wherein the acquisition means acquires the <u>information of printers</u> second list data on the basis of information obtained from at least one of an operating system and control software for the printing apparatus (column 2, lines 17-67, wherein the user access a group of printers and selects one thereby including an acquisition means to acquire information about the printer).

Regarding Dependent claims 5 and 18, Although Ohta describes accessing multiple printers which inherently includes the name of the printer before the user selects the printer he fails to explicitly teach other

print list conditions such as paper size...etc. (note: only one of the conditions below has to be met, although Ohta does teach one Lin better discloses many of the printer conditions). Lin discloses wherein the printing condition selection list includes at least one of information about a model of the printers, information about a paper size for printing by the printers, information about a paper type for printing by the printers, and information about a layout for printing by the printers (fig 7 & column 2, lines 30-61, wherein the condition selection list includes printer model, paper size, paper type etc..). Ohta teaches a device connecting to a network to access a group of printers. Lin also teaches a device accessing a group of printers further allowing the device to have all the features of a particular printer by having a universal driver; these features make up the printing condition list. Both Lin and Ohta are analogous art because they are from the same field of endeavor of network printing. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a printing condition list prior to printing. The motivation for doing so would have been to allow the user to have access to all the features of a particular printer thereby improving the print quality of the information. Therefore it would have been obvious to combine the teachings of Lin and Ohta for improving the quality of printed documents by allowing the user to have full access to the printer features by implementing a universal driver.

Regarding Dependent claims 15 & 19, Ohta discloses wherein the another apparatus has the data to be printed, further comprising: download means for downloading the selected data to be printed from the another apparatus (column 5, lines 10-15, wherein the print job includes downloading the information on the data to be printed).

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

8.   Applicant's arguments filed April 14, 2006 have been fully considered but are moot in view of the new ground of rejection.

Conclusion

Other Prior Art Cited

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sperry et al. (U.S. 5,995,723) discloses "Client Subsystem For Changing Document/Job Attributes In A Network Printing System"

- Aoki (U.S. 6,369,907) discloses "Network System, Printer, And Information Memory Medium"

- Simpson (U.S. 6,606,162) discloses "Network Printer Groups"

- Richter et al. (U.S. 6,678,068) discloses "Client Print Server Link For Output Peripheral Device"

- Torii (U.S. Pub 2003/0204590) discloses "Network Device Management System And Method Of Controlling Same"

- Spitzer et al. (U.S. Pub 2003/0233428) discloses "Remote Updating Of Printer Settings On A Client Device In A Networked Environment"

- Aidinejad (U.S. Pub 2004/0085573) discloses "Printing Accessory For Mobile Client Device"

- Allen et al. (U.S. Pub 2004/0143651) discloses "System And Method For Distributing Configuration Changes Made To A Printing Device"

- Ishii (U.S. 7,052,190) discloses "Printing Processing Device And Method Thereof"

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner
July 7, 2006

CESAR PAULA
PRIMARY EXAMINER